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OFFICE OF PETITIONS

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In re Patent No. 7,989,376 : DECISION ON REQUEST
Margaryan : FOR
Issue Date: August 2, 2011 : RECONSIDERATION OF
Application No. 10/054,328 : PATENT TERM ADJUSTMENT
Filed: January 21, 2002 : and
Atty Docket No. RAR-5423-2 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition filed on May 23, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, five hundred and nine days (1,509) days, or one thousand, three hundred and ninety-one (1,391) days¹.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, forty-eight (1,048) days is **GRANTED to the extent indicated herein.**

Patentees dispute the reduction to the patent term adjustment for applicant delay of 2,090 days. Patentees maintain that only a reduction of 688 days is appropriate.

¹ It is noted that the instant petition concerns matters that are most appropriately treated under 37 CFR 1.705(b). The instant petition was filed on May 23, 2011, prior to the payment of an issue fee and was timely under 37 CFR 1.705(b). The application matured into the subject patent without the benefit of a decision on the petition under 37 CFR 1.705(b). The matters most appropriately considered under 37 CFR 1.705(b) are now being considered, notwithstanding the petition is considered under 37 CFR 1.705(d).

A review of the application file history reveals that the reduction to the patent term adjustment under 37 CFR 1.704(c)(3) was not calculated correctly by the Office or the patentees. Further to this point, it is noted that 37 CFR 1.704(c)(3) provides:

(c)Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(3)Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i)The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii)The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

A review of the application file history reveals that the subject application became abandoned on February 19, 2004, after applicants failed to respond to a final Office action mailed November 18, 2003. A Notice of Abandonment was mailed July 1, 2004. A petition under 37 CFR 1.137(b) was first filed June 6, 2006. The record demonstrates that the petition under 37 CFR 1.137(b), was not deemed grantable as evidenced by decisions mailed April 25, 2007, June 6, 2008, January 6, 2009, April 1, 2009, and October 28, 2009. A petition under 37 CFR 1.137(b) filed February 26, 2010, was granted on March 22, 2010. It appears, however, that petition under 37 CFR 1.137(b), filed June 6, 2006, was grantable. Pursuant to 37 CFR 1.704(c)(3), a period of reduction to the patent term adjustment of 960 days is warranted with said period beginning on the date of abandonment of the application, February 19, 2004, and ending the date that is four months after the date the grantable petition to revive the application was filed, October 6, 2006. Further review of the file history reveals that a reduction to the patent term adjustment under 37 CFR 1.704(c)(4) of 642 days is also warranted, with said period beginning on the day after the date

two months from the mailing date of the notice of abandonment, September 2, 2004, and ending on the date a petition to revive the application was filed, June 6, 2006.

It is noted that period of reduction under 37 CFR 1.704(c)(4) entirely overlaps with the period of reduction under 37 CFR 1.704(c)(3). **It is, therefore, appropriate to enter only the period of reduction to the patent term adjustment of 961 days. The period of applicant delay of 2,090 days is being removed and a period of 961 days entered.**

In view thereof, the patent term adjustment is 1,048 days (1,509 days of "A" delay + 500 days of "B" delay - 961 days of Applicant delay.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand, forty-eight (1,048) days.**

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Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,989,376 B2

DATED : Aug. 2, 2011

INVENTOR(S) : Margaryan

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (0) days

Delete the phrase “by 0 days” and insert – by 1,048 days--